

Serial No. 09/840,488

PEES et al.

ACY/33350-03

6,255,609, which also claims priority under 35 USC §119 of PCT/US 98/05615, filed on March 23, 1998. The Applicant is also pursuing a reissue procedure regarding patent number 6,255,609 which will clarify priority claim dates. Applicant therefore requests the §102 rejections to be withdrawn.

The Examiner also rejected claim 9 under 35 USC §112, first paragraph, because the Examiner believes the specification does not support Zinc. To satisfy enablement under §112 the specification must enable one of reasonable skill in the art to make and use the invention without undue experimentation.¹ The specification in the application enables of the reasonable skill in the art to make use the invention because the mere fact that formula (III) appears not to call for a metal having a valence state of +1 will not cause one of reasonable skill to engage in undue experimentation. The reason for this is that it would be understood by one of reasonable skill in the art that valence state of a metal has no impact on the success of a transmetallation reaction. One of reasonable skill in the art would understand that the valence state of the metal in such a reaction would not be critical. Therefore, one of reasonable skill in the art, upon reading the specification, would understand how to make and use the invention without undue experimentation. For the foregoing reasons, the applicant requests the §112 rejection to be withdrawn.

FEE UNDER 37 C.F.R. §1.17(e):

The respective \$790.00 fee set forth in 37 C.F.R. §1.17(e) for this petition are to be charged to be paid by credit card (form PTO-2038 enclosed).

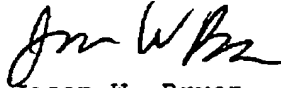
¹ In re Wands, 859 F.2d 731, 8 USPQ2d 1400 (CAFC 1988); MPEP §2164.01(a)

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Respectfully submitted,
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